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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,036	02/09/2004	Gideon Roberts	1568.605	6911
44208	7590	10/06/2005	EXAMINER	
DOCKET CLERK PO BOX 12608 DALLAS, TX 75225			GELIN, JEAN ALLAND	
			ART UNIT	PAPER NUMBER
			2688	
DATE MAILED: 10/06/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,036

Applicant(s)

ROBERTS, GIDEON

Examiner

Jean A. Gelin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the Applicant's amendments and arguments received July 17, 2005 in which claims 1 and 5 have been amended, and claim 8 has been added. Claims 1-8 are currently pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seekins et al. (US 5,937,351) in view of Sykes et al. (5,784,418).

Regarding claims 1 and 5, Seekins teaches a method for taking measurements in a mobile telecommunications system, the system comprising a network of a plurality of cells and at least one user equipment device (as shown in fig. 1), the method comprising, at the user equipment device (100) when the user equipment is camped on a cell (when the mobile station is just powered on): scanning frequency bands to generate measurement data for signals received from cells of the network (i.e., upon power on the mobile station begins scanning the preferred control frequencies to find the strongest carrier signals, col. 2, lines 45-67 to col. 3, line 14).

Seekins does not specifically teach when the signals received from cells of the network include more than one signal per frequency, generating measurement data for more than one signal per frequency.

However, the preceding limitation is known in the art of communications. Sykes teaches receiving a first digital broadcast signal and a reference information in a first frequency band, and selecting the best signal from the converted signal in the first frequency band (col. 3, lines 55-65). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Sykes within the system of Seekins in order to send two signals, such a digital broadcast signal and a reference information signal, in a single frequency band such that adjacent carrier interference can be reduced and smaller bandwidth to transmit data is needed.

Regarding claim 3, Seekins in view of Sykes teaches all the limitations above. Seekins further teaches determining whether the measurement data meets a predetermined criterion and storing the measurement data in an order relative to the meeting of the criterion (col. 2, lines 45-54, col. 4, lines 18-42).

4. Claims 2, 4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seekins et al. in view of Sykes further in view of Schwinke (US 2003/0069019).

Regarding claims 2 and 6, Seekins in view of Sykes teaches identifying from the generated measurement data the cell which best meets a cell selection criteria (i.e., determining if the signal meet the criteria, col. 3, lines 15-25); determining whether the identified cell is suitable (col. 3, lines 15-49).

Seekins in view of Sykes does not specifically teach when the identified cell is deemed unsuitable, identifying the cell with the next strongest signal at any frequency and determining whether the newly identified cell is suitable.

However, the preceding limitation is known in the art of communications. Schwinke teaches when the first operating band is not available, the cellular phone tunes to the second operating band and scans for the strongest signal to camp on (sections 33-38). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Schwinke within the system of Seekins and Sykes in order to provide a method for reducing the number of blocked phone calls and increase the cellular phone call capacity.

Regarding claims 4 and 7, Seekins in view of Sykes teaches all the limitations above except when the identified cell is deemed unsuitable, re-initiating the scanning step with the omission from the scan of the frequency band of the cell previously identified as the cell which best meets a cell selection criterion.

However, the preceding limitation is known in the art of communications. Schwinke teaches when voice channel is unavailable in the first carrier, switching to the second carrier, and scanning the second carrier for the strongest signal (sections 33-38). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Schwinke within the system of Seekins and Sykes in order to provide a method for reducing the number of blocked phone calls, increase the cellular phone call capacity, and make the system faster by reducing the number of channels to scan.

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5. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Seekins et al. in view of Sykes further in view of SO (US 2004/0137926).

Regarding claim 8, Seekins et al. in view of Sykes teaches all the limitations above except a UMTS user equipment.

However, the preceding limitation is known in the art of communications. So teaches in a UMTS, a UE may search an appropriate cell when the user turns on the power, read frequency stored in an internal memory to search appropriate cell (paragraphs 34-39). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the UE device taught by So within the system of Seekins and Sykes in order to improve cell search operation and reduce a registration time.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-7 of US Application # 10/775,029 contain every element of claims 1-7 of the instant application and as such anticipate claims 1-7 of the instant application.

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This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, except that the instant application is broader than the US Application # 10/775,029.

"A later US patent application claim is not patentably distinct from an earlier US patent application claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (571) 272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEAN GELIN
PRIMARY EXAMINER

JGelin
October 1, 2005

A handwritten signature in cursive script that reads "jean Allard Gelin". The signature is written in black ink and is positioned to the right of the typed name and title.